



UNITED STATES PATENT AND TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, DC 20231
www.uspto.gov

H21

Mitchell R. Swartz ScD, MD, EE
16 Pembroke Road
Weston, MA 02493

MAILED

MAY 28 2003

Office of the Director
Group 3600

In re application of :
Mitchell R. Swartz :
Application No. 09/586,426 :
Filed: December 26, 2000 :
For: METHOD TO CONTROL REACTIONS :
INVOLVING ISOTOPIC FUEL WITHIN A :
MATERIAL USING ORTHOGONAL :
ELECTRIC-FIELDS :

DECISION ON PETITION
UNDER 37 CFR 1.181

This is a decision on the petition under 37 CFR 1.181, filed April 19, 2003, received in the Office on April 28, 2003, presumably for the review of the examiners Advisory Action mailed on April 15, 2003. There is no fee for this petition.

The petition is **GRANTED-IN-PART**.

On February 3, 2003, the Office mailed a Final Office action, rejecting the claims over 35 U.S.C. §§ 101, 102, 103, 112 and 132.

On March 28, 2003, the Office received a reply to the Final Office action that amended claims 1, 5, 10, 21, 22, 24, 26 and 28.

On April 15, 2003, an advisory action was mailed which indicated that the amendment of March 28, 2003 would not be entered since new issues were raised by the amendment and since the amendments did not place the application in better form for appeal.

The comments on the advisory action and the rejections made in the Final Office action have been reviewed and are addressed below. Additionally, it is noted that applicant made reference to new material or matter rejections throughout the petition. The advisory action, however, merely states that the amendments raise new "issues" rather than new matter. In that a Final Office action closes prosecution on an application, the examiner may consider any amendment thereafter a new issue if it is deemed to require further consideration by the examiner.

Regarding the addition of the phrase "heat or a nuclear product" in claims 1, 10 and 21 the comment in the advisory action indicating that this is a new issue is deemed within the examiners boundary. In the Final Office action at page 25, the examiner stated that the claims were vague,

indefinite and incomplete as to what is actually the product. The phrase "heat or a nuclear product" raises at least one issue that was not previously addressed, namely what constitutes a "heat product". Additionally, the alternative language may not have overcome the examiner's rejection, in that in the context of applicant's specification the difference between heat and nuclear is unclear. Therefore the examiners statement is proper.

With respect to claims 5 and 22, the rejection of these claims in the Final Office action wherein the examiner indicated the phrase "the group" lacked antecedent basis is found to be in error and is hereby withdrawn.

In any event, regarding the amendments to these claims, the amendment to claim 5 changing "the isotopic fuel" to "said isotopic fuel" would not raise any new issues. Additionally, the amendment to claim 22 changing "the material" to "said loaded material" would not raise any new issues. However, it should be noted that the term "material" should be changed to "metal", since the term refers to the metal that is being loaded.

With respect to claims 24, 26 and 28, changing the phrase "said isotopic fuel impact a barrier" to "said isotopic fuel stopped by a barrier" is considered a new issue in that the act of an object impacting a barrier does not necessarily stop the object but may cause it to rebound or deflect. Therefore, the examiner would have a cause to consider this to be a new issue that was not previously before him.


Finally, it is noted that throughout applicant's comments, it is alleged that the examiner has "demanded" that applicant amend the claims. However, a review of the file indicates that no such demands have been made. The examiner has rejected the claims as not meeting the requirements of the various patent statutes. Applicant has the burden to overcome these rejections as he sees fit. If applicant chooses to amend the claims in an attempt to overcome the rejection, care should be taken not to raise any new issues after final rejection.

In summary:


- 1.) The rejection of the phrase "the group" in claims 5 and 22 in the Final Office action under 35 USC § 112, second paragraph has been withdrawn.
- 2) Upon filing a notice of Appeal, the amendments to claims 5 and 22 would be entered if filed in a separate amendment. This amendment should also change the term "material" to "metal" as indicated above.
- 3.) The examiner's statement indicating new issues with respect to the amendment to claims 1, 10, 21, 24, 26 and 28 is deemed proper.

Any questions or comments with respect to this decision should be forwarded to Supervisory Patent Examiner Michael J. Carone in writing.

This application will be forwarded to central files for Technology Center 3600 to await a response from applicant.



Donald T. Hajec, Director
Technology Center 3600
(703) 306-4598 (facsimile)


DTH:mc:5/20/03